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Response
D. Small-Logan
12/6/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Kazuhiko HARA et al.

Serial No. 09/438,786 ✓

Filed November 12, 1999

: Docket No.00144/122111US

: Group Art Unit 2861

: Examiner K. Feggins

INK-JET RECORDING APPARATUS

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**SECOND REQUEST TO WITHDRAW THE FINALITY OF THE
OFFICE ACTION MAILED OCTOBER 3, 2001 AND
REQUEST FOR CLARIFICATION OF THE SAME**

Assistant Commissioner for Patents,
Washington, D.C.

Sir:

This is a second request that the finality of the Office Action mailed October 3, 2001 be withdrawn. It is Applicants' belief that, despite the Advisory Action of November 26, 2001, the final rejection is premature and should be withdrawn for the three reasons discussed in detail below.

(1) In the Office Action of April 25, 2001, claims 1-4, 6-9, 11-14, 16-18 and 21-23 were rejected over prior art. However, claims 5, 10, 15, 19 and 20 were indicated as being allowable if rewritten in independent form.

In the response filed July 31, 2001, claims 5, 10, 15, 19 and 20 were redrafted as new claims 28, 33, 38, 42 and 43. These new claims were drafted to place the claims in better U.S. form. The scope of claims 28, 33, 38, 42 and 43 is the same as that of original claims 5, 10, 15, 19 and 20. However, in the final Office Action mailed October 3, 2001, the Examiner has withdrawn the indication of allowability of claims 42 and 43.

MPEP 706.07(a) states that a final rejection is proper on a second or subsequent action on the merits, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an

Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). Note that the information relied upon by the Examiner was not submitted in an IDS during the period set forth in 37 C.F.R. § 1.97(c).

Not only is the Examiner introducing a new ground of rejection that was not necessitated by the amendment, the final rejection is the first time that claims 42 and 43, which correspond to original claims 19 and 20, have been rejected. Note that rejecting previously allowed claims is not to be taken lightly, as indicated in MPEP 706.04, it is clear that such action cannot be taken in a final rejection.

In view of the fact that claims 42 and 43 are rejected for the first time in the Office Action of July 3, 2001, it is submitted that the finality of the previous Office Action is premature and must be withdrawn.

In response to the above comments, the Examiner has indicated in the Advisory Action that the changing of the term "flashing" to "flushing" in the claims changed the scope of the claims and necessitated the new grounds of rejection. However, the terms "flashing" and "flushing" are merely descriptive terms used to describe the claimed signal. It is submitted that changing this term does not change the scope of the claims. If the Examiner maintains that this change of language necessitates the new grounds of rejection, the Examiner is requested to explain how the references relied upon in the first Office Action taught a "flashing" signal as recited, but do not disclose a "flushing" signal and therefore, necessitated the new grounds of rejection.

(2) Further, regardless of the fact that the original claims were cancelled and replaced with new claims, the Examiner cannot make the Office Action of October 3, 2001 final because of the fact that the Office Action of April 25, 2001 was defective. In the Office Action of April 25, 2001, the Examiner rejected claims 9, 11-14 and 16 under 35 U.S.C. §103(a) as being unpatentable over Kobayashi in view of Applicants' Admitted Prior Art (AAPA). The Examiner indicated that page 18, line 33 and Figure 6 of the present application's specification was prior art. However, as detailed in the Amendment filed July 31, 2001, the Examiner cannot arbitrarily indicate that a portion of the detailed description of the invention is prior art in order to use it to reject claims in the same application. The fact that the Examiner made this completely improper rejection alone necessitates that the Office Action of October 3, 2001 be made non-final.

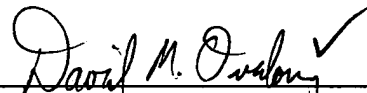
(3) In addition, since the Examiner has again neglected to address the fact that the Office Action of September 3, 2001 fails to treat claims 28, 33 and 38, even though the cover sheet indicates that claims 24-50 have been rejected. As a result, this failure to address each and every pending claim renders the Office Action of September 3, 2001 defective. Clarification of the status of these claims is also requested.

In view of the above-mentioned reasons, immediate withdrawal of the finality of the Office Action of October 3, 2001 is requested.

Respectfully submitted,

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